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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,330	08/09/2000	Luis Eduardo Gutierrez-Sheris	Unisphere-13/2	5198
32137	7590	02/12/2004	EXAMINER	
COWAN, LIEBOWITZ & LATMAN, P.C. 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036			KARMIS, STEFANOS	
			ART UNIT	PAPER NUMBER

3624

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,330

Applicant(s)

GUTIERREZ-SHERIS, LUIS
EDUARDO

Examiner

Stefano Karmis

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on 20 November 2003.

Status of Claims

2. Claims 1-23 have been left as originally filed. Claims 24-29 have been added. Therefore, claims 1-29 are under prosecution in this application.

Summary of this Office Action

3. Applicants' amendment filed on 20 November 2003 have been fully considered, and discussed in the next section below or within the following rejection. Claims 1-29 are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

Response to Applicants' Amendment

4. The Examiner acknowledges Applicant's arguments in the remarks with respect to the 35 U.S.C. § 103 of Downing U.S. 5,963,674 in view of Risafi U.S. 6,473,500 and withdraws the rejection as stated in the previous office action. Any arguments with respect to the claims are considered moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 8, 14, 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (hereinafter Phillips) U.S. Patent 6,615,189 in view of Ito et al. (hereinafter Ito) U.S. Patent 6,039,250.

Regarding independent claims 1, 8, 14, 18 and 24, Phillips teaches a system and method for transferring funds comprising, collecting a sum of money, via a money-transfer company, from a customer for transfer to a beneficiary, activating one of said money pick-up devices and generating a corresponding personal code, via said distributor and said money-transfer company, giving the beneficiary an activated one of said money pick-up devices and a corresponding personal code; and operating one of said money dispensing machines to collect said sum of money via said beneficiary using said activated one of said money pick-up devices and said corresponding personal code (column 4, lines 1-45). Phillips fails to teach, providing a beneficiary with a unique device pick-up code, presenting the code to a distributor and activating the money pick-up device based on the pick-up code. Downing teaches a fund transfer system in which a beneficiary is supplied with a pick-up code and the pick-up code is presented to an ATM machine to obtain the fund transfer. It would be obvious to someone of ordinary skill in the art, that the teachings of Phillips comprising that an activated money pick-up device is supplied directly to the beneficiary, could be modified to include teachings of Downing in which the beneficiary needs a defined pick-up code to obtain the desired funds left by the customer. Thus requiring the beneficiary in Phillips to supply a specific pick-up code before the distributor sends the card. There is sufficient motivation to combine the teachings of Downing with the teachings of Phillips, both inventions deal with the transferring of funds to a beneficiary. While Phillips teaches that the beneficiary is supplied with a card to access the funds, Downing teaches that a "card is not required" (column 13, lines 51-54), however Downing mentions that the system can be

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incorporated on conventional ATM's, thus requiring the beneficiary to use a form of credit, debit, or IC card to obtain the money transfer.

Claims 2-7, 9-13, 15-17, 19-23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (hereinafter Phillips) U.S. Patent 6,615,189 in view of Ito et al. (hereinafter Ito) U.S. Patent 6,039,250 in further view of Risafi et al. (hereinafter Risafi) U.S. Patent 6,473,500.

Claims 2, 9, 25, 27 and 29, Phillips teaches the activation of a card obtained from a distributor via a telephone (column 4, lines 17-30. Both Phillips and Ito fail to teach characteristics of activating and assigning PIN to be used in conjunction with the card. It would be obvious to someone of ordinary skill in the art that the teachings of both Phillips and Ito could be modified to include the teachings of Risafi, because Risafi discloses a fund transfer method in which a beneficiary is supplied with a money-pick up device to be used in money dispensing terminals. Risafi does not disclose if the customer or the distributor supplies the card loaded for the beneficiary but it is reasonable to assume that either may provide the beneficiary with the card to obtain the transfer of funds. Risafi teaches that the card activation step includes transmitting PIN from the distributor to the processing center, and then transmits another PIN from the processing center back to the distributor (column 4, line 61 thru column 5 line 10).

Claims 3 and 10, Risafi teaches sending unique device identification during the transmitting of the unique device pick-up code (column 4, line 61 thru column 5 line 10).

Claims 4 and 11, Risafi teaches distributor identification is sent to the processing center (column 16, lines 11-32 and Figure 4).

Claims 5, 12 and 15, Risafi teaches that the step of transmitting the unique device pick-up code includes transmitting signals from the distributor to the processing center via a telephone network and the step of transmitting the distributor identification includes transmitting a number identification to the processing center (column 16, lines 11-32).

Claims 6, 13 and 16, activating the card requires that the number identification be matched prior to transmitting the PIN from the processing center back to the customer (column 16, lines 11-32).

Claims 7 and 17, Risafi teaches that the money dispensing machines are ATM machines and providing the recipient with a money pick-up device provides the recipient with an ATM card having a magnetic stripe (Figure 3) and personal identification number (column 6, lines 36-64).

Claims 19, 20 and 26, Ito teaches identifying the beneficiary by the customer and requires a fund pick up number that is provided by the customer (column 5, lines 28-40).

Claim 21, Risafi teaches providing the recipient with a PIN after receipt of the fund pickup number by the distributor and the dispensing money step is carried out only

upon receipt by the money dispensing machine of the personal code (column 6, line 38 thru column 7 line 18).

Claim 22, Risafi teaches supplying the activated card to the recipient (column 4, line 61 thru column 5, line 10).

Claim 23, Risafi teaches that the fund pickup number may be communicated between a recipient and a network of agents or distributors (column 3, line 53 thru column 4, line 16).

Claim 28, Phillips teaches supplying the activated money pick-up device to the beneficiary (column 4, lines 1-9).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Walker et al., US Patent 5,949,044 Sept. 7, 1999. Method and apparatus for funds and credit line transfers.
- b) Hilt et al., US Patent 6,408,284 Jun. 18, 2002. Electronic bill pay system for consumers to generate messages directing financial institutions to pay a biller's bill.
- c) O'Leary et al., US Patent 6,609,113 Aug. 19, 2003. Method and system for processing internet payments using the electronic funds transfer network.

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d) McDonald et al., US Patent 6,648,222 Nov. 18, 2003. Internet-based zero intrinsic value smart cards with value data accessed in real time from remote database.

e) Levine et al., US RE38,255 Sep. 23, 2003. Method and apparatus for distributing currency.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.



Respectfully Submitted
Stefano Karmis
February 2, 2004

VINCENT MILLIN
SUPERVISOR
TECHNOLOGY CENTER 3624